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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/377,827 | 08/20/1999 | AKIRA SUGIYAMA | 1453.1001/JD | 8358 |
| 21171 | 7590 | 05/05/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | FLETCHER, MARLON T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2837 | |

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/377,827

Applicant(s)

SUGIYAMA, AKIRA

Examiner

Marlon T Fletcher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh et al. (5,038,659) in view of Tanimoto (4,450,743).

As recited in claims 1 and 6, Satoh et al. disclose a musical score apparatus including a data processor (3) using a computer and a staff notation comprising: a keyboard (2) for inputting character or symbol data into the data processor (3) as discussed in column 3, lines 51-61; tables corresponding with data input into the data processor with character and scales of music staff notation as discussed in column 5, line 67 through column 6, line 2, and column 9, lines 8-25, and as can be seen in figures 17-19; a note decoder for decoding the input data to correspond to scales or notes of a scale as discussed in column 3, lines 46-61; column 6, lines 7-9 and lines 20-23; and column 8, lines 52-57; a note code storage device (7) memorizing an output from the note decoder as discussed in column 5, lines 4-7; and an output means (4) for outputting musical notation as discussed in column 5, lines 8-14. Further, with respect to claim 6, Satoh et al., also disclose that the note code tables or data correspond with non-music staff character or symbol data as discussed in column 3, lines 51-61 and column 9, lines 8-25. Inherently, Satoh et al. provide note code tables as can be understood from column 9, lines 8-25.

While Satoh et al. do provide the use of tables, Satoh et al. do not disclose a table providing a listing of note codes that correspond to the input data, in the manner specifically claimed.

However, as recited in claims 1 and 6, Tanimoto discloses note code tables that correspond to the input data as seen in and discussed in columns 5 and 6, which correspond to figures 1-4, wherein input data and note codes also correspond to musical staff notation.

As recited in claims 2-5 and 7, Tanimoto discloses a data processor, wherein the note code table is a list corresponding data input to musical scales or phrases of music staff notation as seen in figure 5, and discussed in column 3, lines 53-66, and as further seen in figure 5 and discussed in column 3, lines 53-66 and as further seen in tables in columns 5 and 6, wherein plural tables are included.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Tanimoto with the apparatus of Satoh et al., because Tanimoto provides a clear correlation of input data with stored table data including note codes to produce output data, wherein Satoh et al. provide correlation of input data with output data, only failing to show a clear correlation with note codes. Satoh et al. clearly shows the correspondence of notes and input characters as seen in figures 18 and 19. It would have been obvious in view of Satoh et al. to provide the input data corresponding with the notes or note codes, as taught by Tanimoto, wherein the combination provides teachings of input data to the conversion of output data, wherein the output data corresponds to musical data.

Response to Arguments

3. Applicant's arguments filed 05/08/2003 have been fully considered but they are not persuasive.


The applicant argues that the references do not suggest any reason or motivation to be combined. The applicant argues that Satoh et al. do not provide note conversion. However, Satoh et al. do provide input conversion and musical score display. Tanimoto provides note conversion and is relied upon for that reason. In combination, the references provide the teachings as claimed by the applicant. While Satoh et al. shows the correspondence or result of the input data in relation to the notes, it is obvious that the same could be shown in a table to show the same relationship. Tanimoto provides the teachings which are partly inherent in Satoh et al., wherein Tanimoto provides a clear correlation of input data with stored table data to provide a musical output representation based on the conversion of input data to output data. Applicant argues that the notes seen in the figures relate to the musical keyboard. However, Satoh et al. provide the correlation of the input, whether matched or converted, providing the teaching of correlating the input data to the note data. In combination, the references clearly provide the teachings of the claimed limitations. The argument of there being no prima facie obviousness case is not disregarded but explained in the office action. The references are combined to show that at the time of the invention was made that it would have been obvious to combine the references, wherein Satoh et al. teach the claimed invention except showing the note codes in a table form. However, Tanimoto provides the deficiency, which is an obvious modification, based on teachings of Satoh et al. which show the conversion of input data to note data. While this action could be made final, in consideration of the applicant, the

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examiner is allowing the applicant to respond to office action. The applicant's representative has made no amendment to claims and continues the argument that there is no prima facie obviousness case provided by the examiner. There is no argument in regards of whether the claim limitations are taught by the references. The argument is based on whether the references should be combined. The examiner disagrees with the arguments regarding a prima case of obviousness not being provided. In conclusion, the rejection remains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 571-272-2063. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107.


Marlon T Fletcher
Primary Examiner
Art Unit 2837

MTF
April 30, 2004